

### **REMARKS**

Claim 3 has been amended, claims 8 and 10 have been canceled without prejudice or disclaimer, claims 1 and 5 are allowed, and claims 1, 3, 5, and 7 are pending and under consideration. This Amendment places the claims in better form for appeal, and entry of this Amendment is respectfully requested. No new matter is presented in this Amendment.

### **REJECTIONS UNDER 35 U.S.C. §102:**

**Claims 3, 7, 8 and 10** are rejected under 35 U.S.C. §102 (a), (b), and/or (e) as being anticipated by Moritani et al. (U.S. Patent No. 6,411,591 and/or WO 99/14764) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on October 2, 2008. Moritani discloses an optical recording medium having a mask layer containing at least one of elements in groups Ib, IIb, IIIa to VIIa, and VIII in 10 to 40 atomic percent and also containing oxygen, and specifically a mask layer which is  $(\text{CoO})_{35}(\text{SiO}_2)_{46}(\text{NaO})_9(\text{CaO})_5(\text{MgO})_4(\text{Al}_2\text{O}_3)_1$ . See Col. 7, lines 52-56, and Col. 5, lines 12-13, respectively.

With respect to independent **claim 3**, tantalum, in  $\text{TaO}_x$ , is found in group Vb of the periodic table, which is not included in the groups listed by Moritani. Moritani does not disclose, inherently or expressly, a mask layer comprising  $\text{TaO}_x$  as recited in **claim 3**. Therefore, it is respectfully requested that this rejection be withdrawn and that **claim 3** be allowed to issue.

**Claims 8 and 10** have been canceled without prejudice or disclaimer, and **claim 7** is allowable for at least similar reasons as described above by virtue of its dependency on allowable **claim 3**.

### **REJECTIONS UNDER 35 U.S.C. §103:**

**Claims 3, 7, 8 and 10** are rejected under 35 U.S.C. §103(a) as being unpatentable over Moritani et al. (U.S. Patent No. 6,411,591 and/or WO 99/14764) as applied above.

**Claim 3** has been amended to comprise  $\text{TaO}_x$  as a mask layer. Moritani teaches a mask layer containing at least one of elements in groups Ib, IIb, IIIa to VIIa, and VIII in 10 to 40 atomic percent and also containing oxygen; however, Moritani does not teach a mask layer containing

tantalum, in TaO<sub>x</sub>, which is found to be in group Vb of the periodic table, which is not included in the groups listed by Moritani. As such, a mask layer containing TaO<sub>x</sub> would not be obvious to one skilled in the art to as Moritani's comprehensive listings of materials exclude the use of tantalum, thereby inherently teaching against such use. Therefore, it is respectfully requested that this rejection be withdrawn and that **claim 3** be allowed to issue.

Because **claim 7** depends upon and incorporates the features of independent **claim 3**, **claim 7** is patentable for at least similar reasons as independent **claim 3**. Namely, **claim 3** recites a mask layer that comprises TaO<sub>x</sub>, which is not disclosed in Moritani. Thus, it is respectfully requested that this rejection be withdrawn and that **claim 7** be allowed to issue.

Because **claims 8 and 10** have been cancelled without prejudice or disclaimer, the rejections of such claims has been rendered moot.

**Claims 3, 7, 8 and 10** are further rejected under 35 U.S.C. §103(a) as being unpatentable over IDS reference to Lin et al. (2002 IEEE journal article title "Study of a super-resolution optical structure: polycarbonate/ZnS-SiO<sub>2</sub>/ZnOX/ZnS-S iO<sub>2</sub>/Ge<sub>2</sub>SB<sub>2</sub>Te<sub>4</sub>/ZnS-S iO<sub>2</sub>"), IDS journal article to Fuji et al. (*Jpn. J. Appl. Phys.*, v39, 2000, pp 980-981), Tseng et al. (U.S. Patent No. 6,506,543), and/or Chen (U.S. Patent Application Publication No. 2003/0228462) in view of Moritani et al. (U.S. Patent No. 6,411,591 and/or WO 99/14764) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on October 2, 2008.

**Claim 3** has been amended to comprise TaO<sub>x</sub> as a mask layer. With regard to the above references, none disclose the use of TaO<sub>x</sub> as a mask layer. Further, as noted above, one skilled in the art would not have been motivated to combine such references to produce a mask layer that comprises TaO<sub>x</sub> as recited in **claim 3**. Both Moritani's and Tseng's comprehensive listings of materials exclude the use of tantalum, thereby inherently teaching against such use. As none of the references even teach the use of tantalum, the combinations of cited references can not render obvious the invention as recited in **claim 3**. Therefore, it is respectfully requested that this rejection be withdrawn and that **claim 3** be allowed to issue.

Because **claim 7** depends upon and incorporates the features of independent **claim 3**, **claims 7** is patentable for at least similar reasons as independent **claim 3**. Namely, **claim 3** recites a mask layer that comprises TaO<sub>x</sub>, which is not disclosed in any of the references cited.

Thus, it is respectfully requested that this rejection be withdrawn and that **claim 7** be allowed to issue.

Because **claims 8 and 10** have been cancelled without prejudice or disclaimer, the rejections of such claims has been rendered moot.

**ALLOWABLE SUBJECT MATTER:**

Claims 1 and 5 stand allowed.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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